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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PERMAN & GREEN
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FAIRFIELD, CT 06824

EXAMINER

NGUYEN, LEE

ART UNIT	PAPER NUMBER
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2682

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DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,488

Applicant(s)

MAKELA ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 21-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 42-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3. 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

Election/Restrictions

1. Claims 21-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Information Disclosure Statement

2. The IDS filed 8/8/2000 and 1/11/2001 have been considered and recorded in the file.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 9-18, 42-44, 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Blakeney et al. (US 5,638,412).

Regarding claim 1, Blakeney teaches a method to select a bearer service for communication between a mobile terminal (6, fig. 1) and a mobile network (4), in which method at least one bearer service is implemented in the mobile network , comprising the steps of: defining a set of requirements (see set of attributes, col. 4, line 45 through col. 5, line 64) for the bearer service (service configuration) to be selected for communication (col. 5, line 38), obtaining information about selectable bearer services (acceptable and alternative configurations, col. 5, lines 50-64), comparing said set of requirements for the bearer service and said obtained information about selectable bearer services (col. 5, lines 50-64), and making a decision to

accept or reject at least one of said selectable bearer services for communication based on said comparison (col. 5, lines 50-64).

Regarding claim 2, Blakeney also teaches that an application is executed in the mobile terminal in that said set of requirements for the bearer service to be selected for communication is defined at least on the basis of properties of said application (col. 8, line 22).

Regarding claim 3, Blakeney further teaches that said set of requirements for the bearer service to be selected for communication is defined at least on the basis of properties of the mobile terminal (see capabilities, col. 8, line 15).

Regarding claims 9-10, Blakeney also teaches that said comparison is performed in the mobile network and in the mobile terminal (col. 5, lines 51-60).

Regarding claim 11, Blakeney also teaches that there is at least one quality of service class defined in the mobile network, that for at least one quality of service class there is implemented at least one bearer service, and that

for an application to be executed a preferred quality of service class is defined (col. 5, lines 13-36).

Regarding claim 12, Blakeney also teaches forming a bearer service request network message on the basis of said set of requirements for the bearer service to be selected for communication in the mobile terminal (col. 9, line 63 – col. 10, line 8), sending said bearer service request network message to the mobile network (col. 9, lines 63 – col. 10, line 8), forming a bearer service reply network message on the basis of said selectable bearer services and said bearer service request network message in the mobile network (col. 9, lines 9 - 19), and sending said bearer service reply network message to the mobile terminal (col. 9, lines 20-30).

Regarding claim 13, Blakeney inherently teaches the steps of defining a new set of requirements for the bearer service to be selected for communication in the mobile terminal, forming a bearer service request network message on the basis of the new set of requirements for the bearer service to be selected for communication, sending said bearer service request network message to the mobile network, forming a bearer service reply network message on the basis of said bearer service request network message and said obtained information about bearer services

selectable in the mobile network, sending said bearer service reply network message to the mobile terminal, in which a decision to accept or reject a bearer service for communication is made based on said comparison in the mobile terminal (see negotiations in col. 10, lines 53-55).

Regarding claim 14, Blakeney inherently teaches the steps of defining a new set of requirements for the bearer service to be selected for communication in the mobile terminal, forming a bearer service request network message on the basis of the new set of requirements for the bearer service to be selected for communication, sending said bearer service request network message to the mobile network, forming a bearer service reply network message on the basis of said bearer service request network message and said obtained information about bearer services selectable in the mobile network, sending said bearer service reply network message to the mobile terminal, in which a decision to accept or reject a bearer service for communication is made based on said comparison in the mobile network (see negotiations in col. 10, lines 53-55).

Regarding claim 15, Blakeney inherently teaches the steps of forming in the mobile network a conditions changed network message on the basis of the changed conditions, in which network message a new bearer service is

suggested, sending said conditions changed network message to the mobile terminal, examining said conditions changed network message in the mobile terminal, wherein one of the following steps is performed in the mobile terminal: accepting the new bearer service, if said new bearer service fulfils requirements for the bearer service, wherein the communication between said mobile terminal and said mobile network in connection with execution of said application is continued with said new bearer service, or rejecting the new bearer service, if said new bearer service does not fulfill requirements for the bearer service, wherein the communication between said mobile terminal and said mobile network in connection with execution of said application is stopped (see negotiations in col. 10, lines 53-55).

Regarding claim 16, Blakeney inherently teaches the steps of forming in the mobile network a conditions changed network message on the basis of the changed conditions, sending said conditions changed network message to the mobile terminal, examining said conditions changed network message in the mobile terminal, forming a new bearer service request network message in the mobile terminal, sending said bearer service request network message to the mobile

network, wherein one of the following steps is performed in the mobile network: accepting the new bearer service, if said new bearer service fulfils requirements for the bearer service, wherein the communication between said mobile terminal and said mobile network in connection with execution of said application is continued with said new bearer service, or rejecting the new bearer service, if said new bearer service does not fulfill requirements for the bearer service, wherein the communication between said mobile terminal and said mobile network in connection with execution of said application is stopped (see negotiations in col. 10, lines 53-55).

Regarding claim 17, Blakeney inherently teaches that there is provided an execution environment and a bearer service selection application programming interface in the mobile terminal, and that said bearer service selection application programming interface is used in communication between at least one application and said execution environment (see col. 8, lines 19-22 and service negotiator 40, col. 8, line 66 through col. 9, line 9).

Regarding claim 18, Blakeney further teaches that there is provided means for obtaining information about the capabilities of the mobile terminal (col. 8, lines 15-19).

Regarding claim 42, Blakeney teaches a mobile terminal (6, fig. 1) for use in a communication system which comprises at least a mobile network (4), at least one bearer service implemented in the mobile network (acceptable and alternative configurations, col. 5, lines 50-64), and means for selecting a bearer service for communication between said mobile terminal and said mobile network (col. 5, line 38-64), and means for defining a set of requirements for the bearer service (see set of attributes, col. 4, line 45 through col. 5, line 64).

Regarding claim 43, Blakeney also teaches that it comprises means for defining said set of requirements for the bearer service to be selected for communication at least on the basis of properties of an application (col. 8, line 22).

Regarding claim 44, Blakeney further teaches that it comprises means for defining said set of requirements for the bearer service to be selected for communication at least on the basis of properties of the mobile terminal (see capabilities, col. 8, line 15).

Regarding claim 46, Blakeney also teaches that it comprises means for obtaining information about selectable bearer services in the mobile network (acceptable and alternative configurations, col. 5, lines 50-64), and

means for comparing said set of requirements for the bearer service and said obtained information about selectable bearer services (col. 5, lines 50-64).

Regarding claim 47, Blakeney also teaches that it comprises an execution environment for executing applications (see col. 8, lines 19-22 and service negotiator 40, col. 8, line 66 through col. 9, line 9).

Regarding claim 48, Blakeney teaches a bearer selection application interface for use in a communication system which comprises at least a mobile network (4, fig. 1), at least one bearer service implemented in the mobile network, and means for selecting a bearer service for communication between a mobile terminal and said mobile network (col. 5, line 38-50), and said mobile terminal comprises an execution environment for executing applications (see col. 8, lines 19-22 and service negotiator 40, col. 8, line 66 through col. 9, line 9), characterized in that the bearer selection application interface is arranged to transfer information between at least one application and said execution environment for defining a set of requirements for the bearer service (see set of attributes, col. 4, line 45 through col. 5, line 64).

Regarding claim 49, Blakeney teaches a network element in a communication system which comprises at least a mobile terminal (6, fig. 1), a mobile network (4), at least one bearer service implemented in the mobile network, and means for selecting a bearer service for communication between said mobile terminal and said mobile network (col. 5, line 38-50), characterized in that network element comprises: means for receiving a set of requirements for the bearer service from the mobile terminal (col. 10, lines 9-19), means for obtaining information about selectable bearer services (col. 10, lines 17-19), means for comparing said set of requirements for the bearer service and said obtained information about selectable bearer services (col. 10, lines 17-19 and col. 5, lines 51-60), and means for making a decision to accept or reject at least one of said selectable bearer services for communication based on said comparison (col. 5, lines 51-60 and col. 10, lines 17-19).

Regarding claim 50, Blakeney teaches a network element in a communication system which comprises at least a mobile terminal (6, fig. 1), a mobile network (4), at least one bearer service implemented in the mobile network, and means for selecting a bearer service for communication between said mobile terminal and said mobile network (col.

5, line 38-50), characterized in that network element comprises: means for obtaining information about selectable bearer services (col. 10, lines 17-19), and means for providing obtained information about selectable bearer services to the mobile terminal (col. 5, lines 50-64).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 4-8, 19-20 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blakeney in view of Rasanen (WO 97/12490) submitted by Applicant.

Regarding claim 4, Blakeney fails to teach that said set of requirements for the bearer service to be selected for communication is defined at least on the basis of user preferences. According to Rasanen, the set of requirements for the bearer service to be selected for communication is defined at least on the basis of user preferences (page 12, lines 23-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rasanen to the system of Blakeney in order to allow user to select his desired rate.

Regarding claims 5 and 7, Blakeney as modified by Rasanen further teaches that there is user subscription information stored in the mobile network, wherein in the method said set of requirements for the bearer service to be selected for communication is defined at least on the basis of properties of said user subscription information (page 8, lines 28-30 of Rasanen).

Regarding claim 6, Blakeney as modified by Rasanen also teaches that traffic capacity of the mobile network is limited, wherein in the method said set of requirements for the bearer service to be selected for communication is defined at least on the basis of traffic situation of the mobile network (page 6, lines 20-29 of Rasanen).

Regarding claim 8, Blakeney as modified by Rasanen also teaches that traffic capacity of the mobile network is limited, wherein in the method the bearer service to be selected for communication is accepted or rejected at least on the basis of traffic situation of the mobile network (page 6, lines 20-29 of Rasanen).

Regarding claim 19, Blakeney as modified by Rasanen also teaches that there is provided means for obtaining information about user preferences (page 12, lines 23-34 of Rasanen).

Regarding claim 20, Blakeney as modified by Rasanen also teaches that the user of the mobile terminal is informed of the selectable bearer services, wherein the user can perform the selection of the bearer service (page 12, line 30 – page 13, line 1 of Rasanen).

Regarding claim 45, Blakeney fails to teach that said set of requirements for the bearer service to be selected for communication is defined at least on the basis of user preferences. According to Rasanen, the set of requirements for the bearer service to be selected for communication is defined at least on the basis of user preferences (page 12, lines 23-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rasanen to the system of Blakeney in order to allow user to select his desired rate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

LEE NGUYEN *Can 4/24/03*
Primary Examiner
Art Unit 2682